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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	
GILBERT P. HYATT	Group Art Unit: 2616
Serial No. 08/464,034	
Docket No. 751	
Filed: June 5, 1995	
For: IMPROVED IMAGE PROCESSING ARCHITECTURE	

PETITION UNDER 37 CFR 1.181(A)(3)
FOR WITHDRAWAL OF AN IMPROPER CONSTRUCTIVE NONELECTION
FOR CLAIMS RECITING SUBJECT MATTER THAT WAS PREVIOUSLY EXAMINED
REGARDING AMENDMENTS FILED UNDER 37 CFR 1.129(A)

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

The Applicant respectfully petitions for intervention of the Commissioner to have withdrawn an alleged constructive election and to have vacated an improper withdrawal of Group II claims in an Office Action dated August 1997. The prior examination of claimed subject matter overcomes the alleged constructive nonelection and withdrawal of Group II claims and 37 CFR 1.129(a) prohibits the alleged constructive nonelection and withdrawal of Group II claims.

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I INTRODUCTION

The Applicant filed an amendment under 37 CFR 1.129(a) (herein "'129(a)") focusing the claims on a particular invention in response to direction given by Group Director Godici (now acting Deputy Assistant Commissioner For Patents) and in accordance with advise given by the Office of the Commissioner[1]. The Examiner disregarded this direction, disregarded the law regarding '129(a) amendments, alleged that the focused claims were constructively non-elected, and withdrew the focused claims from prosecution.

Restriction and constructive election are **prohibited** by '129(a). First, '129(a) **requires** consideration "on the merits" for the amended claims (Section II), but a restriction requirement and a constructive election do **not** constitute consideration "on the merits". Second, a '129(a) amendment **must** be treated the same as a continuation application (Section III). It is well established that a continuing application is **not** limited to any prior examination nor any constructive election of any previously examined invention (Section III). Examination starts from the beginning with a continuation application just as it **must** with a '129(a) amendment. Hence, the restriction requirement, the constructive election, and the withdrawal of Group II claims each violates '129(a).

The Examiner has not properly considered '129(a) nor the PTO guidelines related thereto and the Examiner has not cited any authority to support this untenable position. The position of the Examiner is **plain wrong**. The alleged constructive election

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1. See Section IV and see the Declaration Of Gilbert P. Hyatt attached hereto as Appendix-II. Further, this direction was confirmed by SPE Razavi. See the Telephone Conference Record attached hereto as Appendix-III.

and withdrawal of Group II claims is **a blatant violation** of '129(a)[2].

This petition incorporates by reference a request/petition filed in the instant application substantially cotemporaneously herewith entitled REQUEST FOR RECONSIDERATION AND/OR PETITION UNDER 37 CFR 1.181 FOR WITHDRAWAL OF AN IMPROPER RESTRICTION REQUIREMENT. This request/petition addresses in more detail the impropriety of the restriction requirement, which supplements the instant petition which more particularly addresses the impropriety of the constructive election and the withdrawal of Group II claims from consideration.

II '129(A) EXPRESSLY REQUIRES THAT THE AMENDED CLAIMS BE CONSIDERED "ON THE MERITS"

37 CFR 1.129(a) specifically prohibits the restriction requirement, the alleged constructive election, and the withdrawal of Group II claims. '129(a) establishes that the Applicant, in return for payment of a fee, "is entitled" to consideration of the claims "on the merits"[3] as a "matter of right".

> "(a) An applicant ... is **entitled** to have a first submission entered and **considered on the merits** ..." [emphasis added] (37 CFR 1.129(a))

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2. It is also noteworthy that the Action is a final first Action that, in addition to failure to provide the required action "on the merits" for the Group II claims that were withdrawn, also fails to consider other submissions that are expressly permitted under '129(a) including amendments, declarations, lists of art, and arguments submitted by the Applicant.

3. "**810 Action on the Merits**
In general, in an application when a requirement to restrict is made, no action on the merits is given." [emphasis in original] (MPEP 810)

"The practical difference between a rejection and an objection is that a rejection, involving **the merits of the claim**, is subject to review by the Board of Patent Appeals and Interferences, while an objection, if persisted, may be reviewed only by way of petition to the Commissioner." [emphasis added] (MPEP 706.01)

"A submission as used in this paragraph includes ... an amendment to the ... claims ..." (37 CFR 1.129(a))

The PTO rule change package states the following regarding '129(a).

> "An applicant will be entitled to have a first submission entered and considered on the merits after final ... if the submission and the fee ... are filed prior to ... abandonment of the application". (1182 Off. Gaz. Pat Office 194, 200)

The Applicant paid the fee (a substantial fee) and met all of the other requirements of '129(a). Hence, the Applicant is "**entitled**" as a "**matter of right**" to examination of the claims proposed under '129(a) (the "'129(a) claims") "**on the merits**"[4]. The Action violates '129(a) by expressly withdrawing the '129(a) claims from consideration and refusing to examine the '129(a) claims. In fact, these '129(a) claims **have not** received an "action on the merits" in violation of '129(a)[5] and, according to the withdrawal of Group II claims, will never receive an "action on the merits" in further violation of '129(a).

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4. The Applicant expressly claimed his right to have the '129(a) submission "considered on the merits" in the petition entitled "PETITION UNDER 37 CFR 1.129(A)". See the first and last paragraphs of that petition.

> "This is a petition under 37 CFR 1.129(a) and MPEP 706.07(g) to withdraw the finality of the Action, to reopen prosecution, and to have the submission after-final rejection entered and **considered on the merits**.
>
> * * *
>
> In view of the above, the Applicant respectfully petitions for withdrawal of the finality of the Action, for prosecution to be reopened, and for the submission after-final rejection to be entered and to be **considered on the merits**." [emphasis added]

5. The application is now under final rejection with an improper final first Action following the '129(a) amendment.

The Applicant's **rights** include examination (i.e., limited reexamination) of the claims.

> "The further **limited reexamination** permits applicants to present for consideration, **as a matter of right**, upon payment of a fee, a submission ..."
> [emphasis added] (MPEP 706.07(g))

> "This will have the effect of enabling an applicant to ... **avoid the impact of refiling** the application to obtain consideration of additional claims ..."
> [emphasis added] (MPEP 706.07(g))

The express right of the Applicant to examination of **the claims** submitted as a part of the submission "on the merits" under '129(a) is violated by the restriction requirement and the alleged constructive election and withdrawal of the Group II claims.

The restriction requirement[6] does **not** constitute examination or "consideration on the merits" infra and hence is **prohibited** by '129(a).

III THE PTO REQUIRES THAT A '129(A) AMENDMENT BE TREATED AS A CONTINUATION APPLICATION, WHICH CAN BE USED TO INTRODUCE A NEW SET OF CLAIMS

A '129(a) amendment was intended to be treated and must be treated as a continuation application infra. Hence, **the constructive election and the withdrawal of Group II claims is prohibited.**

The PTO confirms that a '129(a) amendment has the same effect as a FWC (File Wrapper Continuation)[7]. **Claims can be**

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6. The instant constructive election and withdrawal from consideration of Group II claims is a part of the restriction requirement.

7. An FWC (File Wrapper Continuation) is a true **continuation** application (37 CFR 1.62).

refocused without limit in an FWC[8]. The PTO Official Gazette states the following.

> "As to the fee required by paragraph 1.129(a), the procedures relating to the first submission provided by paragraph **1.129(a)** is equivalent to the filing of a **file wrapper continuation application** under paragraph 1.62 and therefore, the fee required with the first submission is appropriately set at the same amount as **a filing fee** ..." [emphasis added] 1174 Off. Gaz. Pat Office 15 (1995); 1182 Off. Gaz. Pat Office 194, 209 (1996)
>
> "In view of the magnitude of the fee set forth in paragraph 1.17(r), the next PTO action following timely payment of the fee set forth in paragraph 1.17(r) will be equivalent to a first action in **a continuing application.**" [emphasis added] See id at 197
>
> "The filing of the submission and the fee under paragraph 1.129(a) is **equivalent to the filing of a continuing application** and will be treated in the same fashion and under the same turnaround time frame as a continuing application." [emphasis added] See id at 209

The PTO expressly acknowledges that the purpose of a '129(a) amendment is to "avoid the impact of refiling", where refiling of a continuation can be used to introduce a new set of claims.

> "This will have the effect of enabling an applicant to ... **avoid the impact of refiling** the application to obtain consideration of additional claims ..." [emphasis added] (MPEP 706.07(g))
>
> "**201.07 Continuation Application** ...
> At any time before the patenting or abandonment of or termination of proceedings on his or her earlier nonprovisional application, an applicant may have recourse to filing a continuation in order to introduce into the case **a new set of claims** and to establish a right to further examination by the primary examiner." [emphasis added] (MPEP 201.07)

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8. "A continuing application enables an applicant to, inter alia, claim inventions disclosed but not previously claimed ... or to replace claims ... with narrower claims ..." CF. In re Bauman, 683 F.2d 405, 214 USPQ 585 (CCPA 1982).

Similarly, the PTO Student's Handbook[9] further confirms that a '129(a) amendment has the same effect as a FWC. Claims can be refocused without limit in an FWC. The PTO Student's Handbook states the following.

> "TRANSITION AFTER-FINAL PRACTICE 1.129(a)
> IF SUBMISSION AND FEE ARE TIMELY FILED, FINALITY OF PREVIOUS REJECTION IS AUTOMATICALLY WITHDRAWN AND SUBMISSION WILL BE CONSIDERED IN THE SAME MANNER AS IF SUBMISSION WAS DENIED ENTRY AND AN **FWC** WAS THEN FILED" [emphasis added] (PTO Student's Handbook, page 58 facing page, chart 65)

The Applicant confirmed his understanding of a '129(a) amendment with the Office of the Commissioner. See Section IV and see the Declaration of Gilbert P. Hyatt attached hereto as Appendix-I.

In view of the above, there can be no question that filing of a '129(a) amendment is the equivalent of refiling of a continuation application and hence **the constructive election and the withdrawal of Group II claims is prohibited.**

IV THE FILING OF FOCUSED CLAIMS WAS IN RESPONSE TO DIRECTION FROM GROUP DIRECTOR GODICI AND IN ACCORDANCE WITH THE ADVICE GIVEN BY THE OFFICE OF THE COMMISSIONER

The filing of focused claims was in response to direction from Group Director Godici. It is improper for the Examiner to interfere with the Applicant's compliance with direction from Group Director Godici[10]. See the Declaration Of Gilbert P. Hyatt attached hereto as Appendix-I.

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9. The "GATT/NAFTA General Agreement on Tariffs & Trade/North American Free Trade Agreement Student's Handbook" by the "U.S. Department Of Commerce, Patent & Trademark Office" (herein "the PTO Student's Handbook").

10. The Examiner was informed of the direction given by Group Director Godici in the Amendment under 37 CFR 1.129(a).

SPE Razavi made a similar suggestion. See the Telephone Conference Record attached hereto as Appendix-II.

The Office of the Commissioner gave expert advice to the Applicant that there was no limitation on refocusing the claims when filing a '129(a) amendment and the Applicant, in reliance thereon, filed prior '129(a) amendments in 28 other applications and filed the '129(a) amendment in the instant application. See the Declaration of Gilbert P. Hyatt attached hereto as Appendix-I.

Notwithstanding the fact that subject matter of the allegedly constructively withdrawn claims was previously examined (see Section VIII) and that the restriction requirement is improper (see the request/petition referenced above), the alleged constructive election and withdrawal is improper for the further reason that the Applicant filed the '129(a) amendment in good faith reliance upon the advise and guidance given by the Office of the Commissioner.

Notwithstanding the above, the alleged constructive election and withdrawal is improper for the still further reason that the Applicant filed prior '129(a) amendments in 28 other applications which had significantly different claims than the claims that were previously examined in those 28 applications and the examiner therein examined these significantly different claims consistent with the advise and guidance given by the Office of the Commissioner.

V THE CONSTRUCTIVE ELECTION AND WITHDRAWAL VIOLATES THE COMMISSIONER'S "CUSTOMER FOCUS" PROGRAM OF BEING FAIR TO "CUSTOMERS"

Patent Commissioner Lehman implemented a "customer focus" program in the PTO and directed examiners to treat applicants as "customers". However, the instant Action violates the Commissioner's direction by accepting significant fees that were paid by the Applicant in good faith for examination of the '129(a) claims and then refusing to examine these same claims "on

the merits". Notwithstanding the requirements of '129(a) to examine all of the submitted claims supra, accepting the fees paid by a "customer" for examination of claims and then refusing to provide the service that was paid for is a violation of the rights of any "customer".

VI THE CONSTRUCTIVE ELECTION AND WITHDRAWAL IS INEQUITABLE AND VIOLATES THE APPLICANT'S RIGHT TO DUE PROCESS

The Applicant was directed by Group Director Godici to focus the claims (Section IV). The Applicant filed '129(a) amendments in response to Group Director Godici's direction and the Applicant paid significant fees **for examination of the focused claims**. This "**entitled**" the Applicant to have the focused claims **examined**. The Examiner **must** examine the focused claims when he accepts the fee payments. The Examiner **must** examine the focused claims that were filed in response to direction of their Group Director. The Examiner **must** examine the focused claims in accordance with 37 CFR 1.129(a). It is inequitable to take the Applicant's fees and then to refuse to examine the claims paid for by those fees and it is inequitable to refuse to examine claims that were filed in response to the direction of Group Director Godici.

The Examiner's position violates the Applicant's right to due process guaranteed by the Fifth Amendment to the U.S. Constitution. The PTO cannot override the Constitutional requirements of due process. Patlex Corp. v. Mossinghoff, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); Patlex Corp. v. Mossinghoff, 758 F.2d 594, 225 USPQ 243 (Fed. Cir. 1985).

Further, the instant application qualifies for transitional rights under 37 CFR 1.129(a) and 37 CFR 1.129(b). The Final Action acknowledged that the instant application qualifies for the transitional provisions of 37 CFR 1.129(a) (Final Action at para. 1) **but the Final Action is silent on 37 CFR 1.129(b)**. The Applicant's right to due process regarding 37 CFR 1.129(a) is violated by denying the Applicant an opportunity to have the

focused claims, filed in response to the direction of Group Director Godici, examined after accepting the significant fee under '129(a). The Applicant's right to due process regarding 37 CFR 1.129(b) is further violated by totally ignoring 37 CFR 1.129(b) and by withdrawing the focused claims from consideration without providing the Applicant an opportunity to have the focused claims examined in accordance with 37 CFR 1.129(b).

VII THE EXAMINER IS JUDICIALLY ESTOPPED FROM REFUSING TO EXAMINE THE '129(A) CLAIMS

The Examiner is judicially estopped from refusing to examine the '129(a) claims through the tactic of constructively nonelecting and withdrawing from consideration the '129(a) claims in a final first Action. Judicial estoppel is an equitable principle that holds a party to a position on which it has prevailed, as against later litigation arising from the same events. Eagle Foundation Inc. v. Dole, 813 F.2d 798, 810 (7th Cir. 1987). By analogy, the Examiner here is estopped from refusing to examine the '129(a) claims "on the merits" in light of the direction given to the Applicant by Group Director Godici, the express requirements of '129(a), and the acceptance of a significant fee in payment for such examination.

> "Where a party assumes a certain position in a legal proceeding, and succeeds in maintaining that position, he may not thereafter, simply because his interests have changed, assume a contrary position."
> Davis v. Wakelee, 156 U.S. 680, 689 (1895). See also U.S. Philips v. Sears Roebuck & Co., 55 F.3d 592, 596, 34 USPQ2d 1699, 1703 (Fed. Cir. 1995).

As the Federal Circuit explained in Sears, judicial estoppel is designed to preserve the integrity of the judicial process by "protecting against litigants who 'play fast and loose with the courts.'" Id at 1703. The Examiner's refusal to examine the focused claims is in direct contravention of Group Director Godici's direction (Section IV) and is in direct violation of the express requirements of '129(a) (Sections II and III).

The Applicant paid significant fees for the '129(a) amendment with the expectation that the focused claims would be examined. It is playing "fast and loose" to charge fees for examination of focused claims and then to refuse to examine the focused claims.

The Examiner previously examined broad claims directed to many different inventions and now the Examiner refuses to examine focused claims directed to a single invention.

In response to Group Director Godici's direction, the Applicant filed '129(a) amendments to focus the claims. The Examiner's flip-flop, from examining broad claims directed to many different types of systems to restricting narrower claims directed to a single invention, is in direct contravention of the Group Director's direction and should not be tolerated. The Examiner, having examined broad claims directed to many different systems and having been informed about the direction given by Group Director Godici (their Director) cannot now restrict and withdraw the focused claims.

VIII PRIOR EXAMINATION OF CLAIMED SUBJECT MATTER OVERCOMES ALLEGATION OF CONSTRUCTIVE NONELECTION

The constructive election is erroneous because the allegedly nonelected Group II claims recite subject matter that was previously examined infra.

The Group II classification (class/subclass 382/299) includes transformation (see parent/subclass 382/276) features[11] which were previously examined. Regarding prior examination of transformation features, see Paper No. 5 at page 14.

The Examiner's description of the Group II classification includes transform, scaling and anti-aliased features[12] which

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11. See the Manual of Classification.

12. See the Examiner's description of the Group II classification in the instant Action.

were previously examined. Regarding prior examination of transform features, see Paper No. 5 at page 14. Regarding prior examination of scaling features, see Paper No. 5 at pages 11, 13, 14 and 32; Paper No. 10 at page 11. Regarding prior examination of anti-aliased features, see Paper No. 10 at page 11.

The Group II claims recite scaling, kernel, memories, display processor, display medium/device, database, scanning, spatial, and making a product features. These features were previously examined. Regarding prior examination of scaling features, see Paper No. 5 at pages 11, 13, 14 and 32. Regarding prior examination of kernel features, see Paper No. 5 at pages 4, 16, 17, 18 and 30. Regarding prior examination of memory features, see Paper No. 5 at pages 3, 4, 6, 11, 16, 19, and 28. Regarding prior examination of display processor features, see Paper No. 5 at pages 13 and 18. Regarding prior examination of display medium/device features, see Paper No. 5 at page 24. Regarding prior examination of database features, see Paper No. 5 at pages 9, 11, 12, 23, 24, 26, 30 and 32. Regarding prior examination of scanning features, see Paper No. 5 at pages 9 and 32. Regarding prior examination of spatial features, see Paper No. 5 at pages 4, 18, and 30. Regarding prior examination of making a product features, see Paper No. 5 at page 9.

IX FAILURE TO GIVE THE REQUIRED FULL FAITH AND CREDIT TO THE ACTIONS OF THE PRIOR EXAMINER RESULTED IN ERRONEOUS NONELECTION AND WITHDRAWAL OF CLAIMS

The instant application had a change in examiners. The instant examiner disregarded the examination of the prior examiner in violation of MPEP 704 and the instant examiner alleged constructive nonelection of Group II claims and withdrew the Group II claims from consideration. This is remarkable because the Group II claims that are alleged to be nonelected recite subject matter that was **previously examined** (Section VIII). MPEP 704 requires that "full faith and credit should be given to the search and action of the previous examiner". Hence, **it is improper for the instant examiner to arbitrarily disregard the previous examination, allege constructive election, and withdraw the Group II claims from consideration.**

> "When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the case or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something." (MPEP 704).

For example, the examiner was changed from Examiner Prikockis on page 1 of Paper No. 10 to Examiner Shalwala on page 1 of Paper No. 21. Also, the examiner identified on the last page of the action was changed from Examiner Prikockis on Paper No. 10 to Examiner Shalwala on Paper No. 21.

X THE CONSTRUCTIVE NONELECTION AND WITHDRAWAL OF CLAIMS FAILS TO ESTABLISH A PRIMA FACIE CASE

The constructive nonelection and withdrawal of claims does not approach the specificity required to establish a prima facie case and to inform the Appellant of the nature of the constructive nonelection and withdrawal of claims as required by 35 U.S.C. 121; 37 CFR 1.142; and 35 USC 132.[13]

Various examples of the non-specific and uninformative nature are set forth in the above cited request/petition regarding the restriction requirement and are further set forth below.

a. The constructive nonelection and withdrawal improperly disregards 37 CFR 1.129(a) which prohibits such action (Sections II and III).

b. The constructive nonelection and withdrawal improperly disregards the express direction of Group Director Godici which guided the Applicant's amendment (Section IV).

c. The constructive nonelection and withdrawal improperly disregards the express direction of the Office of the Commissioner and the direction of the Commissioner's customer focus program (Sections IV and V).

d. The constructive nonelection and withdrawal violates the Applicant's Constitutional right to due process by denying the Applicant his rights under 37 CFR 1.129(a) and 37 CFR 1.129(b) (Section VI).

e. The Examiner is judicially estopped from making the instant constructive nonelection and withdrawal of Group II claims (Section VII).

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13. See also 37 CFR 1.106(b); Chester v. Miller, 906 F.2d 1574, 1578, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990) ("Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection."). See also In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

f. The constructive nonelection and withdrawal improperly ignores the prior examination of subject matter in the Group II claims (Sections VIII and IX).

g. The constructive nonelection and withdrawal is improperly based upon unsupported conclusionary statements.

h. The constructive nonelection and withdrawal is grossly inconsistent, restricting and withdrawing a previously examined invention while 12 different system inventions were previously examined without restriction.

i. The constructive nonelection and withdrawal fails to address individual claims, relying instead on general statements regarding groups of claims.

The burden of establishing a prima facie case rests with the examiner. This burden is not satisfied by unsupported conclusionary statements.

The Examiner must support the constructive nonelection and withdrawal of Group II claims with a proper explanation and must provide acceptable evidence or reasoning. In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). However, the Examiner bases the constructive nonelection and withdrawal of Group II claims on erroneous, unsupported, and conclusionary statements; but does not provide a proper explanation and does not provide acceptable evidence or reasoning.

Since the constructive nonelection and withdrawal of Group II claims does not establish a prima facie case, the constructive nonelection should be withdrawn and the withdrawal of Group II claims should be vacated. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

XI RELIEF REQUESTED

For the reasons set forth above, the Applicant respectfully petitions for withdrawal of the alleged constructive election and for vacating of the withdrawal from consideration of the Group II claims in the Office Action dated August 1997 and for an action "on the merits" for all claims as required by 37 CFR 1.129(a).

Please charge any fees associated with the papers transmitted herewith to Deposit Account No. 08-3626. A Declaration claiming small entity status has been filed herein.

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 with the express mail label number EM302980167 on October 13, 1997.

Respectfully submitted,

Dated: October 13, 1997

Gilbert P. Hyatt
Registration No. 27,647
P.O. Box 81230
Las Vegas, NV 89180
Phone (702) 871-9899

APPENDIX-I

DECLARATION OF GILBERT P. HYATT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	
GILBERT P. HYATT	Group Art Unit: 2616
Serial No. 08/464,034	
Docket No. 751	
Filed: June 5, 1995	
For: IMPROVED IMAGE PROCESSING ARCHITECTURE	

DECLARATION OF GILBERT P. HYATT

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

I met with Group Director Godici on October 24, 1995. Group Director Godici asked me to file amendments that better focused the claims on a different invention in each application in order to simplify examination and I agreed.

I telephoned the Commissioner's office about December 1995 for information on filing amendments under 37 CFR 1.129(a) in response to the direction of Group Director Godici. I was transferred to Examiner Jessica Harrison. She told me that she was a primary examiner in art unit 3304, a game art unit, that she was on detail to and was temporarily working in the Commissioner's office, and that her permanent PTO telephone number was 703-308-2217. She told me that she had received special training in 37 CFR 1.129 and that she had a copy of a training document on guidelines for the transitional rules, which included 37 CFR 1.129.

I told Examiner Harrison that I planned to file amendments under 37 CFR 1.129(a) and that I wanted to refocus the claims to completely different inventions than originally examined. I asked if there was any limitation on refocusing the claims in an amendment under 37 CFR 1.129(a). Examiner Harrison said that

there was no limitation on refocusing the claims, that an amendment under 37 CFR 1.129(a) was equivalent to filing a File Wrapper Continuation application regarding refocusing the claims, and that an amendment under 37 CFR 1.129(a) would be treated the same as a File Wrapper Continuation application.

In reliance on the advice and guidance that I received from Examiner Harrison and the direction that I received from Group Director Godici; early in 1996 I did file amendments under 37 CFR 1.129(a) in 28 other applications, refocusing the claims in these 28 other applications on completely different inventions than originally examined therein. The examiners in those 28 other applications did examine the refocused claims consistent with the information provided by Examiner Harrison.

In further reliance on the advice and guidance that I received from Examiner Harrison and direction that I received from Group Director Godici; about the second quarter of 1997 I did file an amendment under 37 CFR 1.129(a) in the instant application.

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 with the express mail label number EM302980167 on October 13, 1997.

Respectfully submitted,

Dated: October 13, 1997

Gilbert P. Hyatt, Inventor
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Las Vegas, NV 89180
Phone (702) 871-9899

APPENDIX-II
TELEPHONE CONFERENCE RECORD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	
GILBERT P. HYATT	Group Art Unit: 2613
Serial No. 08/460,422 (Plus 16 other applications. See Appendix)	Examiner: Jon Chang
Docket No. 730	
Filed: June 2, 1995	
For: IMPROVED IMAGE PROCESSING ARCHITECTURE	

TELEPHONE CONFERENCE RECORD

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

This is a telephone conference record in 17 applications listed in Appendix-I attached hereto.

SPE Razavi telephoned the Applicant's representative, Vincent Turner, on April 30, 1997 to discuss the Decision On Petition dated April 16, 1997. The broad nature of the claims and the claiming of multiple inventions was discussed. The claiming of a line sync system, a topographical system, and a map system were particularly mentioned. SPE Razavi stated that examination would be simplified if the claims were focused. In particular, SPE Razavi suggested that the Applicant (1) focus each application on a single invention; e.g., a topographical system rather than claims directed to many different systems and (2) indicate the basis in the specification for the particular claimed invention.

Dated: May 27, 1997

Respectfully submitted,

Vincent Turner

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APPENDIX-I

SUBJECT PATENT APPLICATIONS

DKT. NO.	SERIAL NO.
702	08/458,143
708	08/457,211
711	08/457,208
713	08/458,004
715	08/456,901
718	08/457,194
719	08/457,197
721	08/456,592
723	08/457,196
726	08/458,791
730	08/460,422
734	08/461,567
737	08/460,612
741	08/464,999
743	08/461,288
747	08/464,007
748	08/464,998

1. In accordance with applicant's request that the "objections and requirements be held in temporary abeyance until allowable subject matter is indicated" (and accompanying citation of 37 CFR 1.111(b) for authority), this request is granted.

2. With respect to applicant's request for "reconsideration for the reasons of record", the Examiner maintains his position as stated in the Final rejection for the reasons already of record. Applicant has not presented any additional issues that would result in changing of the Final rejection and all of the previous arguments have been fully addressed in the previous Office Actions.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Mancuso whose telephone number is (703) 305-3885. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au, can be reached on (703) 305-6604. The fax phone number for the organization where this application or proceeding is assigned is (703)308-6306 and 308-6296.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8576.

JM
December 28, 2000

JOSEPH MANCUSO
PRIMARY EXAMINER